



Patricia Lewis
#22/105
Docket No.: 5914
7.23.03

IN THE UNITED STATES PATENT AND TRADEMARK OFFICE

APPLICANT: David Sprogis

GROUP: 3622

SERIAL NO: 09/627,870

EXAMINER: S.M. Gravini

FILED: 07/28/2000

FOR: SYSTEM AND METHOD FOR
DIGITALLY PROVIDING AND
DISPLAYING ADVERTISEMENT
INFORMATION TO CINEMAS
AND THEATRES

RECEIVED
JUL 17 2003
GROUP 3600

Assistant Commissioner of Patents
P.O. Box 1450
Alexandria, VA 22313-1450

Sir:

INFORMATION DISCLOSURE STATEMENT

In compliance with 37 C.F.R. §§1.56, 1.97, and 1.98, Applicant submits copies of the documents listed on the attached Form PTO-1449.

The listed documents were recently cited in a third party submission dated June 2, 2003 in connection with a corresponding European Patent Office (EPO) application. A copy of the third party submission is being submitted herewith for purposes of convenience, together with a copy of applicant's response that is being filed in the EPO.

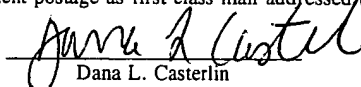
Applicant believes that no fee is required, however, the Commissioner is authorized to charge Deposit Order Account No. 19-0079 for any fee in connection with this filing that is required.

Respectfully submitted,



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I hereby certify that this paper (along with any paper referred to as being attached or enclosed) is being deposited with the United States Postal Service on the date shown below in an envelope, with sufficient postage as first class mail addressed to the Commissioner of Patents, P.O. Box 1450 Alexandria, VA 22313-1450.


Dana L. Casterlin
July 10, 2003
Date

LIST OF PRIOR ART

1. A manual relating to a Scala info channel product which bears the date 23 July 1996.
2. A printout of a leaflet entitled Computer World which is undated.
3. A leaflet headed Bergens Tidene which is dated 24 July 1998.
4. A leaflet entitled Digital Program Delivery containing information regarding the July 1994 digital film distribution by United Artists.
5. A document headed A Brief History of Film and Digital Cinema.
6. A copy of an Editorial in Los Angeles Times relating to Packard Bell plans dated 28 April 1992.
7. An undated document headed E-Cinema Main Report.
8. A document headed CAPA enters new advertising channel dated 5 August 1998.
9. A letter dated 15 December 1999 to Chris Hagan.
10. Two Screen Digest's E-Cinema Alert numbers 85 and 86 dated 4 and 14 October 2002 and which contain information regarding various methods of digital film distribution said to have occurred earlier than April 1999.
11. Two contract documents dated 1998 and 1999
12. US Patent No. 4761641 in the name of Craig Schreiber.
13. US Patent No. 5392066 in the name of Fisher.
14. US Patent No. 5761601 in the name of Nemirofsky.
15. An article headed making digital cinema actually happen - what it takes and who's going to do it.
16. Brief abstract details of Canadian Patent No. 2231376 in the name of Orad.
17. A full article from the Los Angeles Times relating to the Pacific Bell unveiling a new way of looking at movie technology.

European Patent Appln. No. 00 957 405.4

Cinecast LLC

Dear Sirs,

In accordance with Article 115(2) EPC, this submission constitutes the comments of the Applicant to the third party observations filed with the letter of 2 June 2003.

Before embarking on an analysis of the observations, some fundamental requirements of the European Patent Convention ought to be borne in mind.

Article 52(1) EPC states that European patents shall be granted for any inventions that are susceptible of industrial application, which are new and which involve an inventive step. Article 54 (1) EPC states that an invention shall be considered to be new if it does not form part of the state of the art and Article 56 EPC, first sentence, states that an invention shall be considered as involving an inventive step if, having regard to the state of the art, it is not obvious to a person skilled in the art.

It will therefore be apparent that the onus is not on the applicant to "prove" that his invention meets the above requirements. On the contrary, the onus rests firmly with the granting authority and any third party to motivate why the claimed invention is to be deemed to be unpatentable under Article 52(1) EPC. A cursory review of the observations filed on 2 June 2003 will immediately establish that the third party has manifestly failed to do this.

Initially, we note that 17 documents, allegedly constituting prior art, have been submitted, though reference would seem to be made to only three of them in the observations. It is therefore not apparent why the remaining fourteen documents have been filed. Furthermore, many of the documents are non-patent literature and the third party has furnished no evidence whatsoever that this literature was made available to the public before the effective filing date of the present application (cf. Article 54(2) EPC).

Turning now to the observations, we note that the third party initially refers to a document entitled "Making Digital Cinema Actually Happen". This document would appear to correspond to document 15 of the third party's "list of prior art". This document is non-patent literature and under the Abstract on page 1 there is the text "Presented at SMPTE 140th Technical Conference, Pasadena, California, October 31, 1998". It is not clear whether it is the document *per se* that was presented at the conference or whether a verbal presentation based on the contents of the document was made. Neither is it apparent from the document when, and indeed if, the document was ever made available to the public. It is established case law (see for example T400/97) that the relevance of an oral disclosure is wholly dependent on how the oral disclosure was perceived by recipients of the information. In fact, in T400/97 the Board found that it is necessary that at least two recipients of the information independently confirm the content of the disclosure.

Even if the contents of document 15 had been made available to the public in some form, we note that the third party simply refers to "the illustration" on page 14 of the document to support his allegation that the subject-matter of claim 1 lacks novelty. Initially, it is to be observed that there are two illustrations on page 14. Furthermore, the third party fails to explain how the features of either of the illustrations can be deemed to correspond to the specific features of the claimed invention. In fact, no motivation whatsoever is provided.

The third party also refers to "the Scala manual" when considering claim 1. This would appear to correspond to document 1 of the "list of prior art". We note that this document also constitutes non-patent literature and, although the document may bear the date of 23 July 1996, no evidence has been furnished to demonstrate that this document was made available to the public on that date, or indeed on any date. Furthermore, this document contains over seventy (70) pages. It is not at all clear where among these 70 pages that the third party believes there to be a disclosure of the claimed invention.

We note that the third party merely "suggests", in the last sentence of the second paragraph on page 1 of the observations, that a number of the documents disclose all the features of claim 1. We would add that the entire observations are simply a suggestion, lacking totally in

motivation.

In the third paragraph on page 1, the third party “contends” that the claim lacks an inventive step. A contention is insufficient to demonstrate lack of inventive step.

In terms of independent claim 9, the third party would seem to be alleging that its subject-matter is derivable from document 1 and/or US Patent No. 5,761,601, corresponding to document 14 in the “list of prior art”. We note that document 14 comprises 29 pages and that the third party fails to even indicate where among this massive amount of information there is a possibly relevant disclosure. Moreover, the third party once more simply “suggests” that the claim lacks novelty and/or inventive step without providing any motivation whatsoever to support this suggestion.

The comments in the paragraph above apply *mutatis mutandis* for the allegations against claim 17.

In view of the above, it is respectfully submitted that the Applicant has not been given a case to answer. The mere allegations, contentions and suggestions provided by the third party fall far short of what can be deemed to be a reasoned statement and clearly constitute insufficient substantiation. All that the Applicant would like to submit at this point is that the third party is plainly wrong when asserting that the broadest claims of the present application read on any digital cinema system. The present application relates to a system for providing highly targeted advertising as specifically claimed in each of the claims, and requires, *inter alia*, the automatic selection of advertisement data responsive to movie or movie show schedule information or other common interest information. The fact that a system of the invention may be used with a digital cinema system does not somehow broaden the claims to cover all digital cinema systems as stated in the observations. None of independent claims 1, 9, 15, 17 or 25 in the present application is that broadly drafted.

In conclusion, the third party has failed to demonstrate that the independent claims of the present application lack novelty or an inventive step. As such, there is no reason to address the allegations raised against the dependent claims.

Obviously, should the Examiner desire further clarification of any of the points raised in this submission, we would be more than happy to oblige.